

Notice of Allowability

Application No.

10/522,504

Applicant(s)

FEHN ET AL.

Examiner

Marc S. Zimmer

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 04/27/07 and the interview conducted 05/17/07.
2. ☒ The allowed claim(s) is/are 10-28.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with William Conger on May 17, 2007.

The application has been amended as follows:

In each of claims 10, 20, and 22, please remove mention of R^2 and its accompanying definition. Please replace the definition of "X" with,

-- where present, is a halogen or hydrogen atom --.

Please replace the definition of "s" with,

-- 0 to 3 --.

In claim 15, line 3, please replace "(e)" with

-- (E) --.

Please make claims 18 and 19 dependent from claims 11 and 12 respectively.

In claims 24 and 25, please replace the word

"carbonyl[triphenylphosphone]rhodium" with,

-- carbonyl[triphenylphosphine]rhodium --.

In claims 13, 26, 27, and 28, please replace ", wherein at least one heat stabilizer is selected" with,

-- further comprising at least one heat stabilizer selected --.

First, it shall be noted that Applicant's remarks were reflective of the fact that they believed the prior art rejection had been stated over SU 1594190, and not SU1512997. Nevertheless, they struck the identically-named rhodium compound over which the rejection had been formulated from claim 11. They had not, on the other hand, amended claim 10 and, thus, the Examiner believed that this claim still embraced the catalyst disclosed in SU 1512997. However, after further discussion, it was concluded that claim 10 had never actually encompassed (acetylacetonato)dicarbonylrhodium (I) as an embodiment of the catalyst component, a fact that the Examiner had not recognized earlier. Formula (I) in claim 10 had, likewise, not been disclosed in a manner to lend proper antecedent basis to at least one of the other compounds mentioned in claim 11, which is why the variables "X" and "s" have been re-defined.

For the purpose of evaluating the claims against the prior art, the phrase "where present" stated in conjunction with the variable "X" is taken to have the same effect as if Applicant had used a subscript to delineate the quantity of X groups in the compound and that subscript had equaled 0 or 1. The original disclosure provides support for an embodiment of Applicant invention where "X" is absent from the structure and, hence, the language "where present" is appropriate. On the other hand, the Examiner has removed the words "each independently" from the definition of "X" because the original disclosure does properly appear to properly support the notion that there can be more than one group "X" in the compound.

Concerning the amendments of claims 13 and 26-28, the language of these claims seemed to indicate that the heat stabilizer had already been mentioned in one of claims 22, 24, or 26 but this was not the case. The language has been modified only slightly to address this matter.

SU 1512997 does not anticipate claim 24 because claim 22 requires component (A) to have vinyl groups only at its ends with all of the substituents on internal silicon atoms being alkyl/phenyl (where alkyl is to be distinguished from alkenyl). By contrast, the prior art discloses a crosslinkable polymer bearing internal vinyl groups.

An updated survey of the prior art did not yield any references more germane than those already of record. Accordingly, claims 10-28 are allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

May 21, 2007


MARC S. ZIMMER
PRIMARY EXAMINER